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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Applicant	TÄnnjes ISI Patent Holding GmbH
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Applicant:	Tönnjes ISI Patent Holding GmbH	Law Office: 113
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APPLICANT'S SUBSEQUENT BRIEF ON EX PARTE APPEAL OF THE
EXAMINER'S FINAL REFUSAL TO REGISTER

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I. INTRODUCTION AND DESCRIPTION OF THE RECORD.

Applicant hereby appeals from the Examiner's final refusal to register Applicant's Mark. Applicant respectfully requests the Trademark Trial and Appeal Board (Board) reverse the Examiner's decision.

On 27 June 2013 Tönnjes ISI Patent Holding GmbH ("Applicant") filed a trademark application for the mark **IDEPLATE** ("Applicant's Mark") for various goods in International Classes 006, 009, and 020 ("Applicant's Goods").

On 30 July 2013 the Examiner initially refused registration of Applicant's Mark under a requirement for a definite identification of Applicant's Goods and for the significance of Applicant's Mark.

On 30 January 2014 Applicant provided a response to the 30 July 2013 office action by amending the identification of goods and indicating the mark has no significance.

On 4 March 2014 the Examiner (a) initially refused registration of Applicant's Mark under 15 USC §1052(d) ("Section 2(d)") based on the allegation that Applicant's Mark is likely to be confused with US Registration No. 4310718 for EPLATE ("Registrant's Mark") for "cards with integrated circuits, etc." in International Class 009 ("Registrant's Goods"); (b) provided information about a potential Section 2(d) refusal over prior pending Application No. 85583249 for EPLATE ("Prior Pending Mark") for "blank electronic chip cards, etc." in International Class 009; and (c) initially refused registration of Applicant's Mark under 15 USC §1052(e)(1) ("Section 2(e)(1)") based on

the allegation that Applicant's Mark is merely descriptive of Applicant's Goods, and continued the request for a definite identification of Applicant's Goods.

On 3 September 2014 Applicant responded to the 4 March 2014 office action by presenting argument that Applicant's Mark is not likely to be confuse with Registrant's Mark, that Applicant's Mark is not merely descriptive, and amending the identification of goods.

On 19 September 2014 the Examiner suspended action on Applicant's Application pending disposition of the Prior Pending Application and maintaining the refusal to register Applicant's Mark under Sections 2(d) and 2(e)(1).

On 29 October 2015 the Examiner issued a final refusal to register Applicant's Mark under Sections 2(d) and 2(e)(1) in which the reference to the now abandoned Prior Pending Application was removed as moot.

On 28 April 2016 Applicant filed a Notice of Appeal to the TTAB. Also on 28 April 2016 Applicant filed Applicant's Appeal Brief.

On 27 June 2016 the Examiner submitted a request for remand to the TTAB, which was granted on 30 June 2016.

On 21 July 2016 the Examiner issued a subsequent final Office Action withdrawing the Section 2(d) grounds for refusal and maintaining the Section 2(e)(1) grounds for refusal.

On 2 September 2016 the TTAB issued an Order giving Applicant sixty (60) days to file a subsequent Appeal Brief.

II. ISSUE.

The issue before the TTAB is whether under Section 2(e)(1) of the Trademark Act, 15 USC §1052(e)(1), Applicant's Mark is merely descriptive of Applicant's Goods.

III. ARGUMENT: APPLICANT'S MARK IS NOT MERELY DESCRIPTIVE OF APPLICANT'S GOODS

A. Introduction.

TMEP Section 1209.01(b) recites the conditions under which a mark may be held to be merely descriptive: "To be refused registration on the Principal Register under Section 2(e)(1) . . . , a mark must be merely descriptive . . . of the goods or services to which it relates." The cases decided under Section 2(e) establish that in order for a mark to be merely descriptive, it must convey "an immediate idea of an ingredient, quality, characteristic, function or feature of the product in connection with which it is used." *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Therefore, Applicant's Goods and the relevant industry must be examined in view of the mark in assessing whether the mark is "merely descriptive" of the goods.

Applicant's Mark is "IDePLATE". Applicant's Goods are "alloys of common metals; non-luminous and non-mechanical metal signs; metal license plates for vehicles; identity plates of common metal; identification tags of metal" International Class 006, "radio frequency identification (RFID) tags; radio frequency identification (RFID) readers; encoded tags of plastic or metal for use in the field of passive labeling,

tracing and tracking of vehicles; vehicle tracking devices comprised of radio frequency identification (RFID) tags and hologram apparatus, all for use in connection with vehicle tracking and vehicle monitoring” in International Class 009, and “plaques made of plastic; identity plates containing numbers, not of metal; numbered identity plates made of flexible plastic for motor vehicles” in International Class 020.

Applicant submits that Applicant’s entire mark “IDePLATE” does not fall within the definitions of “merely descriptive” under Section 2(e), but instead is at least suggestive of Applicant’s Goods. There is a thin line between a suggestive term and a descriptive term. *Union Carbide Corp. v. Ever-Ready, Inc.*, 188 USPQ 623 (7th Cir. 1976); *In re Quik-Print Copy Shop, Inc.*, 203 USPQ 624 (TTAB 1979). Any doubts concerning the descriptiveness of a mark are to be resolved in favor of the Applicant. *In re Micro Instrument Corp.*, 222 USPQ 252, 255 (TTAB 1984); *In re LRC Products Ltd.*, 223 USPQ 1250, 1252 (TTAB 1984).

B. The USPTO Is Allowing Registration of Marks Similar To Applicant’s Mark.

According to the USPTO TESS database as of 1 November 2016, of which the TTAB should take judicial notice:

- Only Applicant has ever applied for the mark “IDePLATE”, thus showing it is not a common term for which others have attempted to apply for registration;
- No one has ever applied for the mark “IDPLATE”, also showing it is not a common term for which others have attempted to apply for registration;

- Five (5) entities have applied for the mark “EPLATE”, two (2) of which were granted registration by the USPTO, showing it is a term for which the USPTO has granted registration, and directly refuting the Examiner’s allegation that this term is not entitled to registration as a commonly used term:

US Registration No. 4310718, registered on 26 March 2013, for use in connection with “cards with integrated circuits; chipcards; electronic circuit cards; encoded electronic chip cards containing programming used to progress a financial transaction; encoded electronic chip cards for progressing a financial transaction; encoded integrated circuit cards containing programming used to progress a financial transaction; encoded smart cards containing programming used to progress a financial transaction; integrated circuit cards and components; magnetic coded cards for progressing a financial transaction; magnetically encoded credit cards; microchip cards” in International Class 009; and

US Registration No. 3182027, registered on 5 December 2006 (canceled under Section 8 on 12 July 2013), for use in connection with “plastic license plates, identity plates and registration plates for vehicles, featuring numbers, letters and/or names, and mounting hardware sold as a unit therewith” in International Class 020.

Even two (2) of the three (3) applications that did not mature into registration were issued notices of allowance:

US Application No. 85583249, allowed on 7 August 2012, for use in connection with “blank electronic chip cards; blank electronic storage media; blank integrated circuit cards; blank magnetic data carriers; blank smart cards;

cards and microprocessors for computers; electronic and magnetic ID cards for use in connection with payment for services; electronic key cards; electronically encoded badges and swipe cards for use with time clocks; encoded identity cards; magnetic coded gift cards; magnetic identifying cards; magnetically encoded debit cards; magnetically encoded identity cards; magnetically encoded key cards; pre-paid telephone calling cards, magnetically encoded; radio frequency identification (RFID) credentials, namely, cards and tags, and readers for radio frequency identification credentials; radio frequency identification (RFID) tags” in International Class 009.

US Application No. 7568875, allowed on 5 June 2001, for use in connection with “hand-held computers” in International Class 009.

None of these registrations or applications even required a disclaimer of any term.

Thus, USPTO precedent allows for the registration of a plurality of marks incorporating the term “EPLATE”, as long as there is some difference in spelling or terminology, without a finding of the marks being merely descriptive under Section 2(e)(1). The fact that Applicant has added the additional letters “I”, “D”, and “E”, further differentiates Applicant’s Mark as non-descriptive.

The Examiner’s final refusal to register Applicant’s Mark should be reversed on this ground alone.

C. Applicant's Mark Is A Unique Combination Of Terms.

Applicant's Mark is a unique combination of terms formed into a unitary term. "IDePLATE" is not an English word, nor does it to Applicant's knowledge have any meaning in a foreign language, any geographical significance, or any significance in the relevant industry. Applicant created the term as a brand name for Applicant's Goods. For a mark to be descriptive, the mark must be understood to describe the goods. *In re Omaha National Corp.*, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Colonial Refining & Chemical Co.*, 196 USPQ 46 (TTAB 1977). Applicant's Mark in general is an incongruous unitary term that would not be grasped by the consumer without some imagination and a mental pause. *In re Shutts*, 217 USPQ 363 (TTAB 1983).

For this specific fact situation involving a composite mark, the applicable standard for a "merely descriptive" determination does not necessarily default to the specifically worded standard presented in TMEP §1209.01(b). Instead, even if Applicant's Mark is composed of descriptive terms, the best applicable standard is presented in those precedential cases dealing with composite marks.

More specifically, according to TMEP §1209.03(d), when descriptive terms are combined, the determination of whether the composite mark also has a descriptive significance turns upon the question of whether the combination of terms evokes a new and unique commercial impression. *Duopross Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F3d 1247, 103 USPQ2d 1753 (Fed. Cir. 2012). Said another way: if the composite has an incongruous meaning as applied to the goods, then the mark comprising the combination of merely descriptive components is registerable. See *In re Colonial Stores Inc.*, 394 F2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE held

not merely descriptive of bakery products); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool).

Even assuming *arguendo* that one component in Applicant's Mark may be a known term, the overall combination and arrangement of the components of Applicant's Mark ***into a single unitary mark*** results in a suggestive and registrable trademark. Applicant is not using any of the components of Applicant's Mark as separate terms, thus giving a distinctly different impression. This is an important distinction in that even if, *arguendo*, those in the relevant industry often use the term "e" and the term "plate" in related products, ***they do not refer to such products as an "IDePLATE"***, as evidenced by the Examiner failing to find the identical mark "IDePLATE" in the USPTO or on-line records.

Therefore, Applicant's Mark - even if a combination of otherwise descriptive words - is more than "merely descriptive" of the applied-for goods under the applicable standard and evokes a new and unique commercial impression in the minds of the relevant consumer. See *The Firestone Tire & Rubber Co. v. The Goodyear Tire & Rubber Co.*, 186 USPQ 557 (TTAB 1975) ("BIASSTEEL" is not descriptive of tires); *Citibank, N.A. v. Citibanc Group, Inc.*, 222 USPQ 292 (11th Cir. 1984) ("CITIBANK" is not descriptive of New York City banking services). Applicant's Mark is associated with sufficient "commercial impression" and/or "incongruous meaning" to merit registration on the principal register.

D. Applicant's Goods Do Not Immediately Come To Mind When Viewing Applicant's Mark.

Importantly, when confronted with Applicant's Mark, Applicant's Goods would not immediately come to mind. Applicant submits that the reasonable consumer in the relevant industry would have to make a mental leap from Applicant's Mark to Applicant's Goods in that when the reasonable consumer is presented with Applicant's Mark and Applicant's Goods, the reasonable consumer would have an "Aha! moment" in connecting Applicant's Mark with Applicant's Goods. As such, Applicant submits that its mark functions as a trademark and is registrable.

Thus, Applicant's Mark when taken **as a whole** and as used in the relevant industry does not inform the public of the nature of Applicant's Goods. Under established law, a mark must not be dissected into individual parts and must be considered as a whole when assessing the descriptiveness or suggestiveness of mark. *See, e.g., Burger Chef Systems v. Sandwich Chef, Inc.*, 608 F2d 875 (CCPA 1979). And, as a whole, Applicant's Mark does not describe the nature or a "*significant* function or attribute" of Applicant's Goods as would be required to render the mark merely descriptive. Specifically, Applicant's Mark does not convey any particular ingredient, quality, characteristic, function or feature of Applicant's Goods **in such specificity** to render Applicant's Mark merely descriptive. The unique combination of the terms "id", "e", and "plate" creates a unique commercial impression that is greater than each term alone and of the sum of its parts. *See Association of Co-operative Members, Inc. v. Farmland Industries, Inc.*, 216 USPQ 361 (5th Cir. 1982).

Additionally, the ***immediate idea*** concerning the ingredients, qualities, characteristics, functions or features of the services must be conveyed with ***particularity***. *Plus Products v. Medical Modalities Associates, Inc.*, 21 USPQ 1119, 1203-1205 (TTAB 1981). Applicant's Mark does NOT inform consumers as to the field in which Applicant's Goods may fit, and Applicant's Mark does NOT convey Applicant's Goods to the relevant consumer with the required amount of particularity to be considered merely descriptive. See *In re Reynolds Metal Co.*, 178 USPQ 296, 296 (CCPA 1973) (reversing the TTAB in allowing registration of "BROWN-N-BAG" for cooking bags).

Under the "imagination test," a common test used by the courts in determining whether a mark is merely descriptive, one must consider how much imagination on the ordinary buyer's part is required to cull a direct message from the term about the product or service. *Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 295 FSupp 479, 160 USPQ 777 (SDNY 1968). The more imagination needed, the more probable the term is properly classified as "suggestive" rather than "descriptive." Section 1209.01(a) of TMEP states:

Suggestive marks are those which require imagination, thought or perception to reach a conclusion as to the nature of the goods or services . . . Suggestive marks, like fanciful and arbitrary marks, are registrable on the Principal Register without proof of secondary meaning. Thus, a designation does not have to be devoid of all meaning in relation to the goods and services to be registrable.

Applicant's Mark is suggestive in that it requires imagination, thought, and perception to reach a conclusion as to the nature of Applicant's Goods (an "Aha! moment"). In fact, competitors will not be deprived of the use of the terms "id" or "e" or "plate" to describe their goods or services but "only of the use of the words in combination as would be likely to confuse" consumers. *In re Reynolds Metal Co.*, 178 USPQ at 297. Thus, competitors merely will be precluded from using a combination of words and/or terms in a manner confusingly similar to Applicant's Mark. See also, *Pacific Industries, Inc. v. Minnesota Mining and Manufacturing Co.*, 425 F2d 1265, 165 USPQ 631 (CCPA 1970) ("IMPACT" for carbonless transfer paper allowed registration); *In re Automatic Radio Manufacturing Co.*, 404 F2d 1391, 160 USPQ 223 (CCPA 1969) ("AUTOMATIC RADIO" for radios allowed registration); *In re Realistic Co.*, 169 USPQ 610 (CCPA 1971) ("CURV" for permanent wave solution allowed registration).

E. Applicant's Competitors Do Not Use Applicant's Mark.

The record shows that competitors of Applicant do **NOT** use Applicant's Mark to describe their similar goods. See, e.g., *In re Minnetoka*, 3 USQP2d 1712 (TTAB 1987) (holding that term "softsoap" was not generic, based at least in part on the finding that "there exists a fairly substantial number of competitors in the business of selling liquid soap ... [and] none of these competitors uses the term 'soft soap' descriptively, generically, or otherwise."). The Examiner supplied no trademark usages of "IDePLATE" for use in connection with goods that are equivalent to Applicant's goods or, indeed, any goods. As discussed above in Section III.B., only Applicant has ever

applied for the mark “IDePLATE”, thus showing it is not a common term for which others have attempted to apply for registration

Applicant also is not aware of a single competitor that promotes its goods as “IDePLATE”. This **lack of use** of the mark by competitors also can be used to help elucidate whether a mark is descriptive or suggestive. See, e.g., *In re Failure Analysis Associates*, 1 USPQ2d (TTAB 1986). If other competitors are not using the mark descriptively, this is strong evidence that the mark is not descriptive. See *Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co.*, 186 USPQ 557 (TTAB 1975) (others not using the mark descriptively is strong evidence that the mark is not descriptive); see also *In re Dollar-A-Day Rent-A-Car Systems, Inc.*, 173 USPQ 1972 (no descriptive use by others is a strong argument that the mark is not descriptive).

In the present case, as no one has even attempted to register a mark consisting of Applicant’s Mark in connection with any goods or services, let alone the same or related goods, this is strong evidence that Applicant’s Mark is not merely descriptive. See, USPTO TESS database where a search for “IDePLATE” only turns up Applicant’s Mark. As such, the Examiner’s initial refusal is deficient in that it does not show that a single competitor promotes its goods under Applicant’s Mark. See *In re Failure Analysis Associates, infra* (the absence of evidence showing competitors used the term “failure analysis associates” supported the finding that the term was not generic).

IV. CONCLUSION.

As any doubts concerning the descriptiveness of a mark are to be resolved in favor of the Applicant, Applicant respectfully submits that its mark functions as a

trademark and is registrable. *In re Micro Instrument Corp.*, 222 USPQ 252, 255 (TTAB 1984); *In re LRC Products Ltd.*, 223 USPQ 1250, 1252 (TTAB 1984).

For the above reasons, Applicant respectfully requests that the Board reverse on appeal the Examiner's final refusal to register Applicant's Mark under Section 2(e)(1) of the Trademark Act (15 USC §1052(e)(1)) as Applicant's mark is not merely descriptive of Applicant's Goods. As such, Applicant's Mark should be allowed registration on the Principal Register pending satisfaction of any remaining requirements for registration.

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